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No. 03-963

In the Supreme Court of the United States

MEDTRONIC VASCULAR, INC., PETITIONER

v.

CORDIS CORP., RESPONDENT

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

MOTION OF PUBLIC KNOWLEDGE FOR LEAVE TO FILE *AMICUS CURIAE* BRIEF AND BRIEF OF PUBLIC KNOWLEDGE AS *AMICUS CURIAE* IN SUPPORT OF THE PETITIONER

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MOTION OF PUBLIC KNOWLEDGE FOR LEAVE TO FILE *AMICUS CURIAE* BRIEF

Pursuant to Rules 21, 29, 33.1, and 37.2 of the Rules of this Court, Public Knowledge hereby moves for leave to file the accompanying brief as *amicus curiae* in support of the petition for writ of *certiorari* in the above-captioned case. Counsel for the Petitioner has consented to the filing of this brief, and Petitioner's letter has been filed with the Clerk.

Public Knowledge was asked to become an *amicus* on February 2, 2004, only four days before filing of this brief. On February 3, 2004, Public Knowledge contacted counsel for a law firm seeking to have that firm represent it in filing a brief *amicus curiae* in support of the petition for certiorari. In the afternoon of February 4, 2004, said counsel informed Public Knowledge that it could not provide such representation. In the evening of February 4, 2004, the undersigned counsel agreed to draft and file the attached amicus brief on behalf of Public Knowledge. On February 5, 2004, the undersigned counsel contacted counsel for Respondent – after Public Knowledge had determined with the Court that a brief was still timely – to request consent to file the attached brief. Because of the late date, however, counsel for Respondent did not have sufficient time to determine Respondent's position in regard to this filing. Accordingly, counsel for Respondent was obliged to withhold its consent at this time.

Filing of this brief will assist the Court in considering the difficult and important legal issues raised by the petition for certiorari. Public Knowledge is a non-profit advocacy group located in Washington, DC. Undersigned counsel is a professor of patent law at the Washington

College of Law, American University, who has previously filed a brief *amicus curiae* on the merits of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 00-1543, which relates directly to the issues raised by the petition for certiorari. Public Knowledge and undersigned counsel have previously submitted a brief *amicus curiae* at the certiorari stage in *Duke University v. Madey*, No. 02-1007.

Filing of this brief also is in the interests of justice. Public Knowledge and its counsel diligently sought to obtain consent of counsel, Petitioner's counsel granted such consent, and Respondent's counsel did not refuse but could not provide such consent. Public Knowledge has a substantial interest in the outcome of the petition. Public Knowledge's mission is to work to ensure that intellectual property law and policy reflect the proper scope of protection intended by the framers of the Constitution and adopted by the Congress, which promote rather than discourage innovation and competition. Public Knowledge's experience before this Court and in other fora makes it well suited to advocate the important public-regarding concerns that this case and this brief present.

Accordingly, Public Knowledge respectfully requests that the Court grant leave to file the accompanying brief *amicus curiae* in the above-captioned case.

Respectfully submitted,

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Statement of Interest of *Amicus Curiae*

This brief is filed on behalf of Public Knowledge (PK).[1] PK is a non-profit advocacy and education organization that promotes a balanced approach to intellectual property law and technology policy reflecting the "cultural bargain" intended by the framers of the U.S. Constitution. PK works to promote fundamental democratic principles and cultural values of openness, access, and the capacity to create and compete. PK advocates for patent policies and laws that ensure that innovation, creativity, and competition are encouraged. PK believes the "clear and unmistakable" disclaimer standard for finding an argument-based estoppel applied by the Federal Circuit in this case: (1) conflicts with this Court's recent holding in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002); (2) conflicts with other Federal Circuit standards for evaluating whether amendments and arguments narrow patent scope and trigger estoppel, unjustly enriches patentees, and lacks historic justification; and (3) will result in increased uncertainty or scope for virtually every patent, hindering competition and harming the public.

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[1] Petitioner's letter of consent has been filed with the Clerk. A motion for leave to file this brief also has been filed, because Amicus Curiae was unable to request the consent of Respondent in sufficient time to allow Respondent's counsel to determine Respondent's position. This brief was not authored in whole or in part by counsel for any party. No one other than *amicus* and its counsel made a monetary contribution to preparing or submitting this brief.

Summary of Argument

The Court of Appeals for the Federal Circuit in this case applied an unduly restrictive view of when arguments (made by an applicant during prosecution to narrow the meaning of claim language) bar application of the doctrine of equivalents during an infringement action. Under this standard, the disclaimer of equivalents must be "clear and unmistakable." *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1358, 1363 (Fed. Cir. 2003). This restrictive standard for estoppel is inconsistent with this Court's recent holding in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). In that case, this Court explained that amendments made to narrow claim language presumptively trigger estoppel, and articulated standards for rebutting this presumption. There is no principled reason to distinguish between argument-based and amendment-based estoppels. Because applicants may choose whether to submit narrowing arguments or amendments, however, the more restrictive standard for finding an argument-based estoppel invites patentees to evade the *Festo* presumption.

The restrictive "clear and unmistakable" disclaimer standard for argument-based estoppel was recently adopted by the Federal Circuit. The standard conflicts with its current and earlier tests for determining when arguments and amendments narrow claim scope and trigger an estoppel. Application of the new standard will unjustly enrich patentees at the expense of the public, granting protection that they neither sought nor obtained and may not deserve. The new standard lacks historic justification and is incoherent, because it fails to recognize the common origins of claim scope and estoppel principles.

The Federal Circuit's "clear and unmistakable" disclaimer standard will increase the uncertainty of or expand patent scope for virtually every patent issued. Similarly, the standard will cause more and more costly litigation. As a result, competitors may refuse to invent and market goods and services or may charge higher prices for the goods and services that they ultimately offer. In either event, the new disclaimer standard will impose significant public harm.

Argument

I. The "Clear and Unmistakable" Disclaimer Standard Is Inconsistent With This Court's Recent Decision in *Festo* and Invites Evasion of *Festo's* Estoppel Principles.

This Court recently held in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002), that narrowing amendments to claim language presumptively estop the patentee from resorting to the doctrine of equivalents to recapture the impliedly disclaimed subject matter in an infringement action. "When the patentee responds to a rejection by narrowing his claims, this prosecution history estops him from later arguing that the subject matter covered by the original, broader claim was nothing more than an equivalent." *Id.* at 727. *See id.* at 737 (by making a narrowing amendment "the patentee [is regarded] as having conceded an inability to claim the broader subject matter or at least as having abandoned his right to appeal a rejection."). Once the presumption applies, the patentee is estopped from asserting the doctrine of equivalents, unless the patentee can meet its burden of

rebutting the presumption in regard to the particular equivalents at issue. *See id.* at 740-41.

Nothing in the Court's dicta or analysis in *Festo* suggests that there should be any difference in treatment when a patentee narrows the meaning of claim language by an argument from when a patentee narrows the meaning of claim language by substituting different terms.[2] Under the Federal Circuit standard applied in this case, however, narrowing arguments made to obtain a patent do not trigger an estoppel unless the disclaimer of claim scope is "clear and unmistakable." *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1358, 1363 (Fed. Cir. 2003). Conversely, if the disclaimer is clear and unmistakable, there can be no rebuttal. This new standard impermissibly shifts the burden of proving disclaimer of the equivalents at issue from the patentee to the applicant.

Not only is the "clear and unmistakable" standard inconsistent with *Festo*, it is unwarranted as a matter of traditional patent law principles. As this Court stated in *Festo,* the patentee should not be able to argue for a narrow application of the claim in the U.S. Patent and Trademark Office (PTO or Patent Office) and for a broad application in infringement. "Were it otherwise, the inventor might avoid the PTO's gatekeeping role and seek to recapture in an infringement action the very subject matter surrendered as a condition of receiving the patent." *Festo,* 535 U.S. at 734

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[2] In the context of the "recapture rule" for broadening reissue patents, the Federal Circuit has acknowledged that there is no reason to distinguish between narrowing arguments and narrowing amendments. *See Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1481 (Fed. Cir. 1998) ("Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender.").

(*citing Goodyear Dental Vulcanite Co. v. Davis,* 102 U.S. 222, 228 (1880)). *See Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (1985) ("the prosecution history (or file wrapper) limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance."). *Cf. Sprigg v. Bank of Mount Pleasant,* 35 U.S. 257, 265 (1836) (traditional civil estoppel applies where "a party has, by his own voluntary act, placed himself in a situation as to some matter of fact, that he is precluded from denying it."). Because applicants may choose whether to submit narrowing arguments or amendments, the Federal Circuit's more restrictive standard for finding an argument-based estoppel will invite patentees to evade the *Festo* presumption. Applicants will now submit arguments rather than amendments in the Patent Office, and will further argue in infringement actions that their earlier prosecution arguments were unclear or mistakable.

II. The "Clear and Unmistakable" Disclaimer Standard Conflicts With Related Federal Circuit Standards, Unjustly Enriches Patentees, and Lacks Historic Justification.

This Court has provided little guidance regarding how to determine whether amendments and arguments narrow claim meaning and thus disclaim literal claim scope and presumptively estop equivalents protection. However, the Federal Circuit at an earlier stage clearly established the appropriate standard for doing so. "The legal standard for determining what subject matter was relinquished is an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history, that the applicant gave up to procure

issuance of the patent." *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 952 (Fed. Cir. 1993). This standard was self-consciously the same standard that the Federal Circuit had applied to determining the scope of claim language in the first instance. *See id.* at 952 n.15. The Federal Circuit en banc subsequently approved of this standard, in a case determining the scope of statutory equivalents of claims drafted in "means-plus-function" claim format under 35 U.S.C. § 112, ¶ 6. *See Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1457 (Fed. Cir. 1998) (en banc) (literal claim scope is to be determined from the perspective of whether "a competitor would reasonably believe that the [patentee] had surrendered the relevant subject matter."). The Court reiterated that the same standard applies to equivalency determinations. *See id.* (*citing Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214, 1221 (Fed. Cir. 1996)).

Notwithstanding this clear history, the Federal Circuit recently established additional and conflicting standards for finding that prosecution arguments impliedly disclaim literal claim scope and equivalents protection. Rather than determining whether and to what extent – as viewed by competitors – claim language was narrowed (and thus presumptively or conclusively triggers an estoppel), courts must now review prosecution arguments for evidence of a clear and unmistakable disclaimer of patentable subject matter. In this case, the Federal Circuit cited for this new standard two earlier decisions, *Omega Engineering, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1326 (Fed. Cir. 2003) (relating to "prosecution disclaimer," or disclaimer of literal claim scope), and *Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1458 (Fed. Cir. 1998) (relating to "argument-based estoppel," or disclaimer of equivalents protection). *See Cordis Corp.*, 339 F.3d at 1358, 1363. *See also Litton Sys.*, 140 F.3d at 1462-63. In turn, *Omega Engineering* cites to

various recent cases and then to *Litton Systems* and *Alpex Computer Corp.* *See* 334 F.3d at 1325, 1326 n.1. *Litton Systems* is mostly concerned with determining the existence of prosecution history estoppel and the rebuttal and scope of estoppel, but in finding prosecution disclaimers cites to *Hoganas AB* for the "clear and unmistakable" standard. 140 F.3d at 1458. The Federal Circuit's "clear and unmistakable" standards for prosecution disclaimer and argument-based estoppel thus conflict with its earlier, related standards regarding claim scope and estoppel.

The Federal Circuit's new standards will create additional confusion and will dramatically restrict the likelihood of finding a disclaimer from narrowing arguments, unjustly enriching patentees at the expense of competitors and the public. Under these standards, arguments that clearly narrow claims may no longer be held to disclaim literal scope or equivalents protection. These standards will thereby provide patentees with a greater scope of protection than they asked for and obtained from the Patent Office.[3] Moreover, whether the narrowing arguments respond to a proper examiner rejection or reflect unilateral recognition that the original claim is overly broad, the new standards may provide protection that patentees could not validly obtain

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[3] Similarly, courts may be less likely to find that ambiguous arguments trigger estoppel. Courts may erroneously apply the "clear and unmistakable" standard to determine whether narrowing has occurred. Alternatively, courts may avoid making any determination regarding narrowing, by finding that there is no clear and unmistakable disclaimer that would estop literal application of the claim or equivalents protection. Courts also improperly may begin to apply a "clear and unmistakable" standard to determining whether amendments narrow the claims).

from the Patent Office.[4] This is clearly improper. *See, e.g., Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990) ("a patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims. The doctrine of equivalents [does not] exist[]...to give a patentee something which he could not lawfully have obtained from the PTO had he tried.") (*citing Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950)).

The Federal Circuit new standards for argument-based disclaimers thus lack historic justification and their relation to other claim scope and estoppel standards is incoherent, because prosecution history claim construction and estoppel doctrines have common origins. Like claim construction, argument-based estoppel, and prosecution disclaimer, prosecution history "[e]stoppel is a 'rule of patent construction' that ensures that claims are interpreted by reference to those 'that have been cancelled or rejected.'" *Festo,* 535 U.S. at 733 (*quoting Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-221 (1940)). These doctrines were developed following adoption by Congress in the 1870 Patent Act of a requirement for distinct claims. *See* Act of July 8, 1870, § 26, 16 Stat. 198, 201 (requiring

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[4] The failure to find a disclaimer in regard to unpatentable subject matter is particularly likely for unenumerated embodiments of the original claims, *i.e.*, examples that were not actually disclosed in the specification. Patentees will argue that they could not have clearly and unmistakably disclaimed what they never described or discussed. *See Johnson & Johnson Assocs. v. R.E. Service Co.*, 285 F.3d 1046, 1052-56 (Fed. Cir. 2002) (en banc) (failure to claim disclosed subject matter dedicates that subject matter to the public); *id.* at 1060 (Dyk, J., concurring) (arguing that "dedication is a species of conscious waiver" that does not result from an invalid, overbroad claims encompassing equivalents).

specifications "particularly pointing out and distinctly claiming the part, improvement, or combination which he claims as his invention or discovery") (currently codified at 35 U.S.C. § 112, ¶ 2).

In numerous early cases, this Court prohibited patentees from "reclaiming" in reissued patents subject matter that they had formally disclaimed or had impliedly disclaimed, by failing to claim subject matter during initial prosecution or by adopting narrowing amendments and arguments during such prosecution. *See, e.g., Leggett v. Avery,* 101 U.S. 256, 259-60 (1879); *Goodyear Dental Vulcanite Co.,* 102 U.S. at 228; *Miller v. Bridgeport Brass Co.,* 104 U.S. 350, 352 (1881); *Mahn v. Harwood,* 112 U.S. 354, 360-61 (1884). As the Court stated in *Miller,* "it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed." 104 U.S. at 352.

The implied-in-law disclaimer principles adopted in the early cases compelled the later result that patentees were estopped from asserting broader constructions of their claims in infringement actions than were allowed during prosecution in the Patent Office. *See, e.g., Hubbell v. United States,* 179 U.S. 77, 80 (1900) ("it is well settled that the claim as allowed must be read and interpreted with reference to the rejected claim and to the prior state of the art, and cannot be so construed as to cover either what was rejected by the Patent Office or disclosed by prior devices.... [The patentee] is not allowed to revive a rejected claim by a broad construction of the claim allowed....") (citations omitted);

Knapp v. Morss, 150 U.S. 221, 224-25, 229 (1893) (same).[5] These principles also compelled the result that patentees could not argue for broader constructions of claims in infringement actions than were supported by a proper construction of their arguments and amendments in the Patent Office. *See, e.g., Weber Elec. Co. v. E.H. Freeman Elec. Co.,* 256 U.S. 668, 677-78 (1921) ("Having thus narrowed his claim ... in order to obtain a patent the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the [arguments and] amendments, which amount to a disclaimer"); *I.T.S. Rubber Co. v. Essex Rubber Co.,* 272 U.S. 429, 443-44 (1926) ("having limited his claim by amendment... limitations imposed by the inventor... must be strictly construed against the inventor and looked upon as disclaimers.").

III. The "Clear and Unmistakable" Disclaimer Standard Will Harm Competitors and the Public By Increasing The Uncertainty or Scope of Virtually Every Patent.

As a result of this Court's decision in *Markman v. Westview Instruments, Inc.,* 517 U.S. 370 (1996) – as implemented by the Federal Circuit – construction of patent claim scope is reviewed *de novo, i.e.,* without any deference

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[5] Further, the doctrine of equivalents was limited until 1950 to determining equivalency within the scope of construed claim language. *See generally* Ronald D. Hantman, *Doctrine of Equivalents,* 70 J. PAT & TRADEMARK OFF. SOC'Y 511 (1988). Thus, these estoppel doctrines were historically applied only to limit later-filed claims and to interpret the scope of narrowed claims, not to determine disclaimer in regard to equivalents outside the scope of application of construed claims.

to the trial court's interpretation. *See Cybor,* 138 F.3d at 1456. The Federal Circuit reverses trial courts on claim construction issues in approximately one half of all the cases that it considers. *See* Institute for Intellectual Property and Information Law, University of Houston Law Center, Decisions for 2002, *at* http://www.patstats.org/2002.html (last visited Feb. 3, 2004). Three-fourths of the findings of infringement under the doctrine of equivalents are reversed (although most of the findings that the doctrine does not apply are sustained). *See id.* Thus, patent scope is highly uncertain and cannot easily be determined prior to litigation and appeal. Patent litigation through appeal is both protracted and expensive.

The Federal Circuit's "clear and unmistakable" disclaimer standard will create even more uncertainty over claim interpretation and equivalents protection. Virtually every patent is issued after some argument is offered by the patentee (with or without an amendment), in order to respond to an initial rejection of some of the claims by the Patent Office. Thus, in virtually every patent the existence and scope of an argument-based estoppel will be at issue. Trial judges and appellate judges will now dispute whether statements made during prosecution are "clear and unmistakable," just as they commonly differ regarding the meaning of claim language. Absent protracted and expensive litigation, competitors and the public will be even less able to determine the scope of issued patents.

The restrictive nature of the Federal Circuit's "clear and unmistakable" disclaimer standard also will prevent a finding of disclaimer in many cases where a reasonable competitor would believe that patent scope was disclaimed. In those cases, patentees will be able to assert broad claim constructions and to resort to the doctrine of equivalents.

The patentee thus will obtain additional patent protection that did not exist before the Federal Circuit's recent change in the law applicable to argument-based disclaimers.

The threat and cost of litigation, combined with the increasingly uncertain and expanded scope of patent protection, will discourage innovators and competitors from inventing and marketing new goods and services. "If competitors cannot be certain about a patent's extent, they may be deterred from engaging in legitimate manufactures outside its limits, or they may invest by mistake in competing products that the patent secures." *Festo,* 535 U.S. at 732. Rather than face litigation, many competitors will chose not to innovate. This will result in fewer alternative patented goods in the marketplace. Products that do enter the marketplace will likely be offered at a higher cost due to the expenses associated with designing around uncertain patents and litigation. The result will cause substantial public harm.

> "The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject matter of the patent will be dedicated ultimately to the public." ... Otherwise, a "zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field," ... and "[t]he public [would] be deprived of rights supposedly belonging to it, without being clearly told what it is that limits those rights."

Markman, 517 U.S. at 390 (citations omitted). These harms are discussed in greater detail in the brief *amicus curiae* filed in this Court by the undersigned counsel for the Consumer Project on Technology in the *Festo* case.

Conclusion

The "clear and unmistakable" disclaimer standard adopted by the Federal Circuit in this case is in conflict with this Court's decision in *Festo*, is in conflict with the Federal Circuit's other standards, unjustly enriches patentees, lacks historic justification, and will result in substantial harm to the public. On February 3, 2004, counsel for Shoketsu Kinzoku Kogyo Kabushiki Co. submitted a petition for certiorari in the *Festo* case, following the en banc decision of the Federal Circuit on remand from this Court. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359 (Fed. Cir. 2003) (en banc). That petition argues that the Federal Circuit departed from the estoppel standards articulated by this Court. The Court should grant both the petition in this case and the petition in *Festo* in order to clarify the proper standards for finding narrowing and for finding estoppel in regard to both claim scope and equivalents protection.

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